

### REMARKS

This Amendment is submitted in response to the Decision On Appeal from the USPTO Board of Patent Appeals and Interferences ("the Board") dated August 6, 2004. In that decision, the Board reversed the Examiner's rejections, but created new grounds for rejections. The decision provides that an appropriate amendment of the claims or a showing of facts related to the claims so rejected, or both, must be submitted by October 6, 2004, which amendment will be remanded to the Examiner. In the present Amendment, Claims 1, 3-4, 7, 9-10 are amended and Claims 18-26 are cancelled. Claims 1-12 and 27-28 are now pending.

### REJECTIONS UNDER 35 U.S.C. § 112, first paragraph

In the Board's Decision, Claims 1-12 and 18-28 are rejected under 35 U.S.C. § 112, first paragraph, for the use of the term "distillation" to describe an electronic signature that is incapable of reconstructing a string of data. While Applicants disagree with the Board's position, in an effort to move the present claims to allowance, the term "distillation" has been removed from the claims. Thus, the 35 U.S.C. § 112, first paragraph rejection is moot.

### REJECTIONS UNDER 35 U.S.C. § 102 and 103

In the Board's Decision, Claims 1, 7, 18 and 26 are rejected under 35 U.S.C. § 102 and, in the alternative, under 35 U.S.C. § 103 in view of Tsuria et al. (U.S. Patent No. 6,466,670 B1 – "*Tsuria*").

*Tsuria* teaches an anti-piracy system for preventing playback of unauthorized digital video recordings. A first signature is generated for local video data that is to be played on a playback device. A second "forbidden" signature, based on video that is never authorized to be played, is transmitted to the playback device. The playback device compares the first signature to the second "forbidden" signature. If the two signatures are the same, then the playback device knows that the local video data is illegal, and the playback device will not play the local video data. (*Tsuria* Fig. 1, col. 7, line 34 to col. 8, line 55).

With reference to exemplary Claim 1, *Tsuria* does not teach or suggest the use of “a linear feedback shift register to generate a first electronic signature.” *Tsuria* is referenced by the Board for the general teaching that data stream can be distilled into a form that is incapable of being reconstructed by direct decipherment. Although Applicants disagree with the Board’s position for reasons described in the Applicant’s Appeal Brief, this feature is no longer at issue since it has been cancelled from Claim 1. While *Tsuria* mentions the step of “computing a forbidden signature, (*Tsuria* col. 4, line 7), *Tsuria* does not teach or suggest the use of any type of shift register to generate an electronic signature.

With respect to exemplary Claim 5, *Tsuria* does not teach or suggest “visually examining said suspected copyright infringing material.” Rather, *Tsuria* teaches away from such a feature since the copyright infringing material in *Tsuria* is prevented from being played back at all. (*Tsuria*, Abstract.)

Since the cited prior art does not teach or suggest all of the limitations of the invention as presently claimed, these rejections should be withdrawn.

**CONCLUSION**

As the prior art cited does not teach or suggest every feature of the present claims, Applicants respectfully request a Notice of Allowance for all pending claims.

No extension of time for this response is believed to be necessary. However, in the event an extension of time is required, that extension of time is hereby requested. Please charge any fee associated with an extension of time as well as any other fee necessary to further the prosecution of this application to **IBM CORPORATION DEPOSIT ACCOUNT No. 09-0447**.

Respectfully submitted,



James E. Boice  
*Registration No. 44,545*  
BRACEWELL & PATTERSON, L.L.P.  
P.O. Box 969  
Austin, Texas 78767-0969  
(512) 343-6116

ATTORNEY FOR APPLICANTS